

Appl. No. 10/632,788
Response Dated May 2, 2006
Reply to Office action dated February 2, 2006

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed February 2, 2006. Claims 1-23 and 25-28 remain pending. Reconsideration and reexamination are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 1-3, 5-9, 12-18, 21-23, and 25-28 are rejected as being unpatentable over Pittman (US 6,123,147) in view of Vlasak. Claims 19 and 20 are rejected as being unpatentable over Pittman in view of Vlasak as applied to claim 1, and further in view of admitted prior art. Claims 4, 10, and 11 are rejected as being unpatentable over Pittman in view of Vlasak as applied to claim 1, and further in view of Alford.

The Examiner asserts that Pittman discloses the invention substantially as claimed except for the forced air furnace. The Examiner asserts that it would have been obvious to have eliminated the modulation of the water heater of Pittman during the dehumidification operation, and to have modified the system of Pittman such that the heating and cooling systems were sized to meet the expected heating and cooling loads in order to eliminate the need for any additional heating and cooling units. The Examiner cites Vlasak as teaching the use of a forced air furnace to provide heating to an inside space, and asserts that it would have been obvious to have modified the system of Pittman such that it used a forced air furnace in order to provide the heating rather than a hot water coil in view of the teachings of Vlasak. Applicants respectfully traverse the rejections.

The Examiner has provided no motivational reasoning as to why one of ordinary skill in the art would modify the device and method of Pittman with the teachings of Vlasak. Vlasak appears to merely teach a forced air furnace with a thermostat, and provides no motivation for modifying the system of Pittman. Pittman likewise provides no motivation for its modification. The only statement regarding why one of ordinary skill in the art would have been motivated to

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modify the system of Pittman with the forced air furnace of Vlasak is "in order to provide the heating rather than hot water coil in view of the teachings of Vlasak." See page 3, lines 3-6 of the Office Action. Vlasak teaches a thermostat for a heating or cooling system, and appears to be completely silent regarding the operation of their furnace at the same time as a cooling unit. Since Vlasak and Pittman fail to provide any motivation for modifying the system of Pittman, and the Examiner has not provided any other motivational reasoning, it would appear that the Examiner is relying on either Applicants' own specification or the mere fact that the references could be combined or modified as the motivation for making the combination, both of which are known to be improper.

MPEP 2143.01 III. states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." and "[a]lthough a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)." MPEP 2143.01 IV. states:

because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)... *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

(Emphasis added). Applicants submit that there is no motivation for one of ordinary skill in the art to combine the teachings of Pittman and Vlasak as the Examiner suggests. Vlasak teaches a thermostat for a heating or cooling system. Applicants submit that neither reference provides any motivation, suggestion, or guidance for combining their teachings as the Examiner suggests. The references are directed to very different systems and methods. Pittman teaches using a conventional hot water heater 32 to heat air that has been dehumidified, while Vlasak teaches a

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thermostat for stabilizing heating system cycle periods and dissipating heat at a substantially constant rate in a system having a forced air furnace. The methods and systems are so different in their structure, function and results, that their combination appears to be contrary to the teachings of each reference.

Additionally, Pittman teaches residential air conditioning systems as providing "refrigeration coils within a plenum of a forced air furnace" and teaches the "furnace blower circulates air across the refrigeration coils, cooling the air, and distributes the cooled air through the house." See column 1, lines 13-16. Pittman then teaches his "invention provides a humidity control system that may be easily retrofitted or added to a residential air conditioning system" and that his "humidity control system uses hot water from the residential hot water heater to reheat air exiting from the refrigeration coils." See column 1, lines 40-44. Pittman thus appears to teach his system as being added to a residential HVAC system already having a furnace, but according to Pittman, the hot water heater should be used as the source of heat to reheat air exiting from the refrigeration coils, and not the furnace. As such, Applicants submit that Pittman actually teaches away from the claimed method because Pittman teaches a system using hot water from a conventional hot water heater for reheating air instead of the existing furnace.

The fact that Pittman teaches using a hot water heater for reheating air instead of the furnace already present in a residential HVAC system of Pittman appears to be a direct teaching away from the claimed methods, and clearly teaches away from a combination with Vlasak. Applicants submit that, upon reading Pittman's teaching of using a conventional hot water heater to reheat the air, instead of the existing furnace, one of ordinary skill in the art would have no motivation for removing the very elements taught by Pittman as his invention in order to achieve the method recited in claim 1. This is particularly so since the heat output of a forced air furnace is typically very different (e.g. much greater) from that of a conventional water heater, and results would likely be very different.

Further, even if one were to combine the teachings of Pittman and Vlasak, one would not arrive at the claimed invention. A combination of Pittman and Vlasak would appear to suggest replacing the hot water heater of Pittman with an additional furnace in order to reheat air exiting

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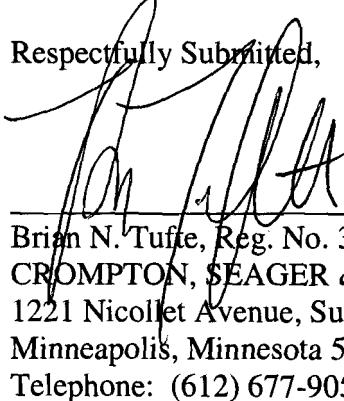
from the refrigeration coils. Applicants submit that such a combination does not teach each and every element of the claims.

Neither Pittman nor Vlasak, alone or in combination, teach or suggest the elements of the independent claims or the claims dependent thereon. Alford does not provide what Pittman and Vlasak lack. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, all pending claims 1-23 and 25-28 are believed to be clearly in condition for allowance. Reconsideration and reexamination are respectfully requested. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

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Respectfully Submitted,



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